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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/518,196  | 07/25/2005  | Kai Desinger         | 3254                | 5577             |
| 21834 7590 05/22/2008<br>BECK AND TYSSER P.L.L.C.<br>2900 THOMAS AVENUE SOUTH<br>SUITE 100<br>MINNEAPOLIS, MN 55416 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| HOLMES, REX R   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3762  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 05/22/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/518,196

**Applicant(s)**

DESINGER ET AL.

**Examiner**

REX HOLMES

**Art Unit**

3762

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 2/5/08 have been fully considered but they are not persuasive. Applicants argue that the markers of Pearson does not extend along the entire axial length of the electrode. The examiner respectfully disagrees. Pearson discloses that a radiopaque marker 11 can be attached, soldered or coated on the electrodes (18) for visualization purposes (¶180).

### ***Claim Objections***

2. Claims 8 and 16 are objected to because of the following informalities: The phrase "preferably" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "preferably"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 11 recite the limitation "a lumen" in line 3 of the claims. There is insufficient antecedent basis for this limitation in the claim. The term is inferentially

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included. It is unclear if the applicant is positively reciting the element. It is suggested to first set forth that the claim has this element before it is used.

***Claim Rejections - 35 USC § 102/103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 3, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearson et al. (U.S. Pub. 2003/0212394 hereinafter "Pearson") or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pearson.

10. Regarding claims 1, 3 and 11, Pearson discloses an electrode needle with a shaft (18), with a casing surrounding the shaft (12), active electrodes on the shaft (18) and a nuclear magnetic resonance marker that is either attached, soldered or coated on the shaft or the electrodes (¶¶ 65, 80).

11. It is noted that the shaft 12 is a metallic slender rod and is considered a wire. Since the electrode is a wire and the marker is on the electrode it anticipates the claim.

12. In the alternative, Pearson discloses an electrode needle discloses with a marker that is either attached, soldered or coated on a wire as described above, but does not explicitly state that the marker is a wire. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the coated wire as taught by Pearson with a wire made out of the marker material, because Applicant has not disclosed that marker wire provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a coated wire as taught by Pearson, because it provides the predictable result of a marker that is observable using nuclear magnetic resonance and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Pearson.

Therefore, it would have been an obvious matter of design choice to modify Pearson to obtain the invention as specified in the claim(s).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 8-10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson as applied to claim 1 above, and further in view of Weber et al. (U.S. Pat. 5,908,410 hereinafter "Weber").

16. Regarding claims 8-10 and 16, Pearson discloses the claimed invention including that the marker is magnopaque and can be located on the sheath, on the electrode inside the casing, or attached before the electrode (¶¶ 65, 80; Figs. 2-11), but Pearson fails to explicitly disclose that the marker is a ferromagnetic material. However, Weber teaches that it is known to use ferromagnetic material as set forth in Column 1, lines 15-21 to provide a disturbance in the magnetic field in a nuclear magnetic resonance field

so as to produce a visible image on the viewing screen of a magnetic resonance imaging device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the magnopaque marker as taught by Pearson, with a ferromagnetic material as taught by Weber since such a modification would provide the device of Pearson with a ferromagnetic marker that would disturb the magnetic field in a nuclear magnetic resonance field so as to produce a visible image on the viewing screen of a magnetic resonance imaging device.

17. Claims 8-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson as applied to claim 1 above, and further in view of Gisselberg et al. (U.S. Pub. 2003/0052785 hereinafter "Gisselberg").

18. Regarding claims 8-10 and 12-16, Pearson discloses the claimed invention including that the marker is magnopaque and can be located on the sheath, on the electrode inside the casing, or attached before the electrode (¶¶ 65, 80; Figs. 2-11), but Pearson fails to explicitly disclose that the marker is a ferromagnetic material and that the ferromagnetic marker is coiled and tuned to the frequency of the Magnetic Resonance Imaging Device. However, Gisselberg teaches that it is known to use coiled ferromagnetic material tuned to a resonate frequency as set forth in Paragraphs 7, 8, 57, 73 and Claim 21 to provide a disturbance in the magnetic field in a nuclear magnetic resonance field so as to produce a visible image on the viewing screen of a magnetic resonance imaging device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the magnopaque marker as taught by Pearson, with a ferromagnetic material as taught by Gisselberg since such a

modification would provide the device of Pearson with a ferromagnetic coiled marker tuned to the magnetic resonance frequency so that it would disturb the magnetic field in a nuclear magnetic resonance field so as to produce a visible image on the viewing screen of a magnetic resonance imaging device.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REX HOLMES whose telephone number is (571)272-8827. The examiner can normally be reached on M-F 8:00 - 5:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R Evanisko/  
Primary Examiner, Art Unit 3762

/R. H./  
Examiner, Art Unit 3762